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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. DOHERTY

Appeal 2008-006174
Application 10/029,928
Technology Center 2400

Decided:[1] June 25, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
ST JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 29-43, which are all of the claims remaining in this

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Data (electronic delivery).

application. Claims 1-28 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Invention

Appellant's invention relates to the field of residential networks. More specifically, the present invention relates to automated control of residential devices using a residential gateway. (Spec. 1, ll. 3-5).

Claim 29 is illustrative:

> 29. A residential gateway that connects a Wide Area Network (WAN) to an in-home network, said residential gateway connecting at least one residential device over said in-home network, the residential gateway;
>
> forwarding state information of said at least one residential device to a control server over said WAN;
>
> forwarding economic setpoint information to said control server over said WAN;
>
> receiving control parameters from said control server over said WAN, said control parameters determined by the control server based on at least the following information: relevant control information accessed from one or more climatic information providing servers on said WAN, said forwarded state information of said at least one residential device and said forwarded economic setpoint information,
>
> whereby said residential gateway controls said at least one residential device based on said received control parameters.

Prior Art

The Examiner relies on the following references:

Mecham	US 6,314,340 B1	Nov. 6, 2001
Petite	US 6,437,692 B1	Aug. 20, 2002

Examiner's Rejection

The Examiner rejected claims 29-43 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Petite and Mecham.

Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claim 29. *See* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

1. Petite discloses a customer workstation that periodically downloads and reviews rain gauge data that can initiate an automatic control signal appropriate with the customer's watering requirements. (Col. 13, ll. 23-28).

2. Mecham discloses in the "Description of Related Art" section, that considerable effort has been expended in developing evapotranspiration formulas which mimic the results provided by the weather station climatic information equations, but do not require access to such large amounts of specific weather station collected climatic information. (Col. 2, 11-16).

3. Mecham discloses that the requested watering needs are compared to a watering budget, with the central control unit granting

permission to actuate the control valves only if the requested irrigation amounts meet any imposed budget limitations. (Col. 18, ll. 55-62).

4. Appellant's Specification does not define what is meant by "economic setpoint."

5. Appellant's Specification states that "a user can configure an economic setpoint for the control of irrigation system 207." "This allows a user to be able to make economic decisions that may give less than optimal performance for his/her lawn, but may yield a lawn acceptable at a given economic point." (Spec. 9, ll. 8-16).

6. Mecham discloses a PC 400 which serves as a centralized control unit with software for managing water resources and controlling and programming the irrigation controller 10, host controller 202, and evapotranspiration module(s) 204. (Col. 17, ll. 61-65). The controllers and modules communicate through communications serial ports 30, 232, and 234. Mecham discloses that the controllers and modules are "networked" together via communications link 236 where each node or element is given a unique address. (Col. 18, ll. 4-9).

APPELLANT'S CONTENTIONS

1. Appellant contends the cited references fail to teach or suggest the limitation of an "economic setpoint" as recited in the independent claims. (App. Br. 8-9 and Reply Br. 1-3).

2. Appellant contends that Mecham "teaches away" from using climatic information from a server. (App. Br. 11).

3. Appellant contends the Examiner relied on impermissible hindsight in combining the teachings of Petite and Mecham. (*Id*).

4. Appellant contends the Examiner did not provide an adequate motivation to combine the teachings of Mecham and Petite. (App. Br. 13).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Has Appellant shown the Examiner erred in determining that the cited references teach or suggest the claimed "economic setpoint?"

2. Has Appellant shown the Examiner erred in combining the teachings of Mecham and Petite?

PRINCIPLES OF LAW

Claim Interpretation

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

Obviousness

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be

"more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

> Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss* v. *Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss* v. *Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellant's Briefs to show error in the Examiner's proffered prima facie case.

ANALYSIS

Issue 1

As noted above, Appellant argues that the cited references, most notably Petite, fail to teach or suggest the claimed "economic setpoint." We disagree for the reasons discussed *infra*.

We do not find that the term "economic setpoint" is specifically defined in Appellant's Specification. (FF 4). We further note that Appellant's Specification does not discuss "economic setpoint information" in the form of some economic measure such as a monetary amount. Accordingly, we broadly but reasonably construe the phrase "economic setpoint" as a measure of controlling water and/or electricity usage based upon an economic determination.

The Examiner relied on Petite to disclose the claimed "economic setpoint." However, we find that Mecham, in fact, teaches actuating control valves by comparing irrigation amounts against any imposed budget limitations. (FF3). Thus, we find that Mecham strongly suggests using an economic determination to control water usage, i.e., an "economic setpoint."

Based on the record before us, we find Appellant has not shown the Examiner erred in determining that the cited references teach or suggest an "economic setpoint."

Issue 2

As noted above, Appellant contends that the Examiner erred in combining the teachings of Mecham and Petite because: (1) the Mecham reference purportedly "teaches away" from using climatic information obtained from servers, (2) the combination of Mecham and Petite is based on hindsight, and, (3) there is a lack of motivation to combine the teachings of the two cited references. (App. Br. 11-14).

Regarding Appellant's contention that Mecham teaches away from obtaining climatic information from servers, we adopt the Examiner's findings as set forth in the Examiner's Answer. (Ans. 9-10). We note that the cited portion of Mecham is not a total discouragement of using climatic information from servers, but instead merely discusses the feasiblilty of using alternative evapotranspiration formulas that do not require access to large amounts of specific weather station collected climatic information. (FF 2).

Further, as noted by the Examiner, Mecham discloses evapotranspiration modules 204 which are coupled to and considered to be part of the controller 10 (col. 9, ll. 39-42 and Fig. 1). Each of the modules is positioned at different zones. (Col. 16, ll. 40-42).

We further find that Mecham strongly suggests a network of controllers and modules that are linked together and given unique addresses. (FF 6). Thus, it is our view that Mecham strongly suggests a "network" which comprises climatic servers (modules). Thus, we disagree with Appellant's assertion that the evapotranspiration modules cannot be equated to servers providing climatic information because the servers are remote and accessible via a wide area network.

As for Appellant's contention that the cited combination of references is based upon hindsight, we disagree.

As pointed out by the Examiner in the Answer, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395 (CCPA 1971) (Ans. 10). In the present case, the Examiner has provided a motivation to combine the references based upon the teachings of Petite and Mecham, and the knowledge of one of ordinary skill in the art, as follows:

> Here, Petite disclosed a control sever that determined control parameters from state information and economic setpoint information but not information from climactic information providing servers. Mecham improves upon Petite's irrigation

> system by providing a system with distributed climatic information providing servers that returned temperature and evapotranspiration information to a control server. This information improves upon Petite's irrigation system because it improves the efficiency for watering the specific site [see Mecham, column 6, lines 50-56]. Thus, one of ordinary skill in the art would have been motivated to modify Petite to incorporate Mecham's teachings. Such a reconstruction is not based on hindsight reasoning but based on Petite and Mecham's teachings and the available knowledge to one of ordinary skill in the art.

(Ans. 10-11).

"[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Here, it is our view that the Examiner's motivation includes knowledge which was within the level of ordinary skill in the art at the time the invention was made, and was not gleaned from Appellant's disclosure.

Moreover, we find the Examiner's proffered modification of Petite by the teachings of Mecham would have been in accordance with what the Supreme Court considers "common sense."

> Common sense teaches, however that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.

(*KSR*. 550 U.S. at 420).

For at least the aforementioned reasons, we find Appellant's arguments directed to the combinability of Petite and Mecham to be unavailing.

REPLY BRIEF

We note that the Reply Brief is properly used to respond to points of argument raised by the Examiner in the Answer and not as a means for presenting new arguments. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). While we have fully considered Appellant's responses in the Reply Brief, we decline to address any new arguments not originally presented in the principal Brief.

CONCLUSIONS

Appellant has not shown the Examiner erred in determining that the cited references teach or suggest the claimed "economic setpoint."

Appellant has not shown the Examiner erred in combining the teachings of Petite and Mecham.

Based on the above, we are not persuaded of error in the Examiner's rejection and sustain the § 103(a) rejection of representative claim 29 and claims 30-43 which fall therewith, over Petite and Mecham.

DECISION

The Examiner's rejection of claims 29-43 under 35 U.S.C. §103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

pgc

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